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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,343	07/26/2004	Hansulrich Reisacher	255666us0pet	6093

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1940 DUKE STREET
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EXAMINER

MANLOVE, SHALIE A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,343

Applicant(s)

REISACHER ET AL.

Examiner

Shalie A. Manlove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/5/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 10 provides for the use of color-mixing systems, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtz et al US 5,082,498.

With respect to claim 1, Kurtz teaches solid pigment formulations comprising: from 70-97% by weight pigment (col. 1, lines 35-col. 2, lines 23), from 3-30% by weight an adduct of ethylene oxide (col. 2, lines 43-55) and 5% by weight or more of sulfonic acids (col. 3, lines 18-24). Kurtz teaches overlapping ranges of the essential substances and amounts (abstract). A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)

As to claims 2 and 3, Kurtz teaches the addition of ethylene oxide with or without propylene oxide to ethylenediamine-adduct (col. 2, lines 43-55).

As to claim 4, Kurtz teaches in general the addition of sulfonic acids as anionic surface – active additives (col.3, lines 18-24).

As to claims 7 and 8, Kurtz teaches in column 3 lines 25-35 and in the examples 1-10 a method of producing the pigment comprising wet-comminuting in the presence of the additive

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and drying or admixing a ready-produced pigment and surfactant by stirring or grinding in an aqueous medium and drying.

As to claim 9, Kurtz teaches the formulations are suitable for pigmenting binder systems dyeing, staining, coloring or printing paper, wall paper, aluminum foil, plasticized or unplasticized PVC, PE, PP, aqueous or aqueous-alcoholic printing ink, gloss paint and leather (col. 3, lines 43-55).

7. Claims 1-4, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belde et al US 4,464,203.

With respect to claim 1, Belde teaches pigment formulations comprising: from 70-95% by weight pigment (col. 2, lines 13-15), from 5-30% by weight ethylene oxide (col. 2, lines 29-65) and 5% -10% by weight of sulfonic acids (col. 3, lines 3-5 and 10-15). Belde teaches overlapping ranges of the essential substances and amounts (abstract). A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)

As to claims 2 and 3, Belde teaches the addition of ethylene oxide/propylene oxide ethylenediamine-adduct (col. 2, lines 29-65).

As to claim 4, Belde teaches in general the addition of sulfonic acids as anionic surface – active additives (col.3, lines 10-15).

As to claims 7 and 8, Belde teaches in column 3 lines 17-25 and in the examples 1-21 a method of producing the pigment comprising wet-comminuting in the presence of the additive

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and drying or admixing a ready-produced pigment and surfactant by stirring or grinding in an aqueous medium and drying.

As to claim 9, Belde teaches the formulations are suitable for pigmenting binder systems dyeing, staining, coloring or printing paper, wall paper, aluminum foil, plasticized or unplasticized PVC, PE, PP, aqueous or aqueous-alcoholic printing ink, gloss paint and leather (col. 3, lines 26-34).

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtz et al US 5,082,498 in view of Nyssen 6,646,023.

As to claim 5, Kurtz teaches the invention as described above. Kurtz does not teach phosphates as an additional additive. However, Nyssen teaches polyphosphates as a water softener for the purpose of increasing the dispersibility of the pigment.

It would have been obvious to one of ordinary skill in the art to employ polyphosphates as taught by Nyssen into the invention of Kurtz in order to enhance the dispersibility of the pigment.

As to claim 6, Nyssen teaches the particle size to be 20-2000 microns, which overlaps the claimed particle size range. A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belde et al US 4,464,203 in view of Nyssen 6,646,023.

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As to claim 5, Belde teaches the invention as described above. Belde does not teach phosphates as an additional additive. However, Nyssen teaches polyphosphates as a water softener for the purpose of increasing the dispersibility of the pigment.

It would have been obvious to one of ordinary skill in the art to employ polyphosphates as taught by Nyssen into the invention of Belde in order to enhance the dispersibility of the pigment.

As to claim 6, Nyssen teaches the particle size to be 20-2000 microns, which overlaps the claimed particle size range. A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/501,328. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because both applications teach pigment granules and preparation thereof comprising a pigment and nonionic surface-active additive based on polyethers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

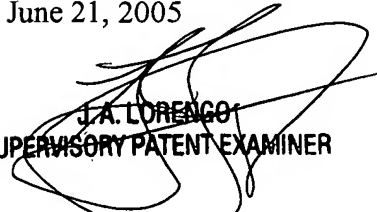
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove
Examiner
Art Unit 1755

June 21, 2005


J. A. LORENCO
SUPERVISORY PATENT EXAMINER